R E M A R K S

Original claims 1-7 have been rejected by the Examiner under 35 U.S.C. 112, first paragraph, as not providing enablement for a fender which is limited only by the properties as set forth in the claims. The Examiner argues that the mere recitation of a rubber composition as recited in the claims provides no compositional ingredients or amounts. For this reason, the Examiner feels that the scope of the claims is much too large, since the claims merely contain a recitation of properties and, as such, do not define the rubber composition contemplated by the present invention.

It is the Applicant's position that the present invention should not be limited to particular rubber compositions, since the rubber compositions which are effective in the present invention, are those which are defined by the parameters already presented in the claims, such as, for example, the rate of change of compressibility, the rate of change of rigidity modulus, the rate of change of elastic modulus, and the like. As noted in the present application, conventional shock-absorbing fenders for marine vessels have not, heretofore, given adequate consideration as to how such fenders function with variations in environmental temperature. The present application defines an invention that identifies the various

properties, which a base rubber material must possess in order to function as a shock-absorbing fender in a variety of environmental conditions. Thus, the present invention, through various investigations has determined how materials of a rubber composition must be characterized in order to be effective as a shock-absorbing fender adapted for environmental changes such as, for example, temperature variations. It is believed that the claims of the present application do in fact, by identifying specific parameters and ranges of said parameters, enable any person skilled in the art to select a rubber composition, which would satisfy the needs of a fender that would function as a shock absorber under the extremes of environmental conditions. As noted on page 23 of the present application, ordinary rubber components are usable as the base rubber material for the shock-absorbing fender of the present invention, however, the base rubber which is selected must contain the necessary tensile strength, elongation, tear strength, compression set and the like, which may be necessary for achieving the compressive properties of the fender as defined in the claims of the present application. Thus, it is believed that the claims, as presently stated do, provide the necessary enablement to select the base rubber material, which will fulfill the needs of the shock-absorbing fender of the present invention.

Claims 1 to 7 have been further rejected by the Examiner under 35 U.S.C. 102(b) or (e) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as being obvious over Tajima et al., U.S. Patent 6,187,420 or Hashimoto, U.S. Patent 6,103,808 or Dailey, U.S. Patent 6,393,655 or Nakahira, U.S. Patent 4,530,386 each taken alone or in the alternative. These rejections are respectfully traversed.

On page 5 of the Examiner's Office Action, the Examiner acknowledges that none of the patents cited in the Office Action letter specifically disclose the properties as claimed in the claims of the present application. Since the Tajima et al. patent appears to be the most relevant of the references relied upon by the Examiner, inasmuch as it is directed to a fender, which provides shock-absorbing properties, the discussion provided herein below will focus on the teachings of the Tajima et al. patent.

Basically, the Examiner is taking the position that since the prior art relied upon in the Office Action letter contains the same or similar rubber compositions as in the present invention, that the references, particularly the Tajima et al. patent, are considered to inherently possess the same properties as that of the present invention and accordingly anticipate or render obvious the claimed invention. The Examiner argues that

it is *prima facie* obvious to optimize properties by manipulating the ingredients in amounts of the rubber composition. However, it is the Applicant's position that the claims of the present application do not merely contain a recitation of generic properties, such as for example, higher or low elastic modulus, higher or low rigidity modulus, or the like, but rather have identified a specific rate of change of elastic modulus and a specific rate of change of rigidity modulus, etc., and thus any rubber composition which would fall within the parameter as defined in the claims of the present application will also define the particular rubber compositions that can be used in the present invention. Thus, the Applicant has discovered, not optimized, specific parameters that make a marine fender particularly effective when operating in a variety of environmental conditions, such as for example, high and low temperature conditions.

The Applicant is not optimizing the teachings of the prior art, because the prior art does not recognize the parameters defined by the present invention nor the problems solved by the Applicant's recognition of these parameters. Certainly, the Tajima et al. patent, if as suggested by the Examiner, contains rubber compositions which fall within the Applicant's claims, also must contain rubber compositions which fall outside the

Applicant's claims, clearly indicating that the Tajima et al. patent as well as all the other references relied upon by the Examiner, do not recognize the problems defined by the Applicant nor the Applicant's solution to said problems.

Accordingly, in view of the above amendments and remarks, reconsideration of the rejections and allowance of the claims of the present application are respectfully requested.

Pursuant to 37 C.F.R. §§ 1.17 and 1.136(a), Applicant respectfully petitions for a one (1) month extension of time for filing a reply in connection with the present application, and the required fee of $110.00 is attached hereto.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Joseph A. Kolasch (Reg. No. 22,463) at the telephone number of the undersigned below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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By _____
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Attachment(s):

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